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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/459,573 12/13/99 LIVSHITS

V 0010-1066

EXAMINER
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HM12/0906

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CONFIDENTIAL	
ART UNIT	PAPER NUMBER

1652  
DATE MAILED:

09/06/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

## Office Action Summary

**Application No.**

09/459,573

**Applicant(s)**

LIVSHITS ET AL.

**Examiner**

David J. Steadman

**Art Unit**

1652

-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_

## DETAILED ACTION

### *Status of the Application*

Claims 1-26 are pending in the application.

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-3, 7, and 11-13, drawn to a bacterium belonging to the genus *Escherichia* expressing the polypeptide of SEQ ID NO:10 and having an ability to produce an amino acid, classified in class 435, subclass 252.33.
  - II. Claims 1-7 and 10-13, drawn to a bacterium belonging to the genus *Escherichia* expressing the polypeptide of SEQ ID NO:12 and having an ability to produce an amino acid, classified in class 435, subclass 252.33.
  - III. Claims 1, 3, 6-8, and 11-13, drawn to a bacterium belonging to the genus *Escherichia* expressing the polypeptide of SEQ ID NO:14 and having an ability to produce an amino acid, classified in class 435, subclass 252.33.
  - IV. Claims 1-3, 9, and 11-13, drawn to a bacterium belonging to the genus *Escherichia* expressing the polypeptide of SEQ ID NO:16 and having an ability to produce an amino acid, classified in class 435, subclass 252.33.

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- V. Claims 14-16, 20, and 24-26, drawn to a method for producing an L-amino acid using a bacterium expressing the polypeptide of SEQ ID NO:10, classified in class 435, subclass 106.
  - VI. Claims 14-20, and 23-26, drawn to a method for producing an L-amino acid using a bacterium expressing the polypeptide of SEQ ID NO:12, classified in class 435, subclass 106.
  - VII. Claims 14, 16, 19, 20, 21, and 24-26, drawn to a method for producing an L-amino acid using a bacterium expressing the polypeptide of SEQ ID NO:14, classified in class 435, subclass 106.
  - VIII. Claims 14-16, 22, and 24-26, drawn to a method for producing an L-amino acid using a bacterium expressing the polypeptide of SEQ ID NO:16, classified in class 435, subclass 106.
2. The inventions are distinct, each from the other because:

The inventions of Groups I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, represent structurally and functionally different polypeptides. Therefore, where structural identity is required, such as for antibody production, the different sequences have different effects.

The polypeptides of Groups I-IV and the method of Group V are related as products and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another

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materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the bacterium of Groups I-IV can be used for protein expression or plasmid propagation and the L-amino acid produced by the method of Group V can be chemically synthesized.

3. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification(s), restriction for examination purposes is proper. "For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP 808.02" (see MPEP 803). The serious burden of search has been established by the different classification of the inventions, thereby requiring divergent patent and non-patent literature searches.

Claims 1-3, 6, 7, and 11-16, 19, 20, and 24-26 will be examined to the extent the claims read on the elected invention.

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*Conclusion*

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The examiner can normally be reached Monday-Friday from 8:00 am to 4:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX number for this Art Unit is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.

  
REBECCA E. PROUTY  
PRIMARY EXAMINER  
GROUP 1800-  
1652